



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/675,858

09/29/00

BOLDA

D

99AB139-A

EXAMINER

MM91/0913

JOHN J HORN
ROCKWELL AUTOMATION
1201 SOUTH SECOND STREET
MILWAUKEE WI 53204

JEANGLAUDE, J

ART UNIT

PAPER NUMBER

2819

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/675,858

Applicant(s)

BOLDA ET AL.

Examiner

Jean B Jeanglaude

Art Unit

2819

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment diled on 07-05-01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2819

Remarks

Due to an agreement with the applicant in an interview done on June 08, 2001 the finality of the final rejection of 04-02-01 is withdrawn and an action on claims 32- 69 is as follows:

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 59 - 69 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 9 of prior U.S. Patent No. 6,252,529. This is a double patenting rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 2819

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 32 – 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 31 of U.S. Patent No. 6,252,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 32 - 39 of the US Application Number 09/675,858 is the same as claim 1 of US Patent Number 6,252,529. By incorporating the limitations of the dependent claims 33 – 39 in the independent claim 32, one obtains the same limitations as claim 1 which was already claimed and patented in US Patent Number 6,252,529.

5. Claims 40, 41 of US Application 09/675,858 is the same as claim 2 of US Patent Number 6,252,529 “ a plurality of solid state switching devices within the feedback resistance circuit and the input resistance circuit and the resistances in the feedback resistance circuit and the input resistance circuit are selectively combinable by changing conductive states of the solid state switching devices.”

6. Claim 42 of US Application 09/675,858 is the same as claim 3 of US Patent Number 6,252,529 “ a control circuit coupled to the solid state switching devices, the control circuit applying control signals to the switching devices to place the switching devices in desired conductive states for combination of the resistances of the feedback and input resistances circuits.”

7. Claim 43 of US Application 09/675,858 is the same as claim 7 of US Patent Number 6,252,529 “ the input resistance of the inverting circuit is a fixed resistance.”

Art Unit: 2819

8. Claim 44 of US Application 09/675,858 is the same as claim 8 of US Patent Number 6,252,529 " the feedback resistance of the non-inverting circuit is a fixed resistance."

9. Moreover, although the conflicting claims are not identical, they are not patentably distinct from each other because claims 45 – 48, 51 of the US Application Number 09/675,858 is the same as claim 27 of US Patent Number 6,252,529. By incorporating the limitations of the dependent claims 46 – 48, 51 in the independent claim 45, one obtains the same limitations as claim 27 which was as already claimed and patented in US Patent Number 6,252,529.

10. Claims 49, 50 of US Application 09/675,858 is the same as claim 28 of US Patent Number 6,252,529 " the plurality of resistances are selectively connectable by a series of solid state switches and the series of solid state switches are configured so that the plurality of resistances are in parallel with one another."

11. Furthermore, although the conflicting claims are not identical, they are not patentably distinct from each other because claims 52 – 55 of the US Application Number 09/675,858 is the same as claim 27 of US Patent Number 6,252,529. By incorporating the limitations of the dependent claims 53 – 55 in the independent claim 52, one obtains the same limitations as claim 27 which was as already claimed and patented in US Patent Number 6,252,529.

12. Claims 56 - 58 of US Application 09/675,858 is the same as claim 28 of US Patent Number 6,252,529 " the plurality of resistances are selectively connectable by a

Art Unit: 2819

series of solid state switches and the series of solid state switches are configured so that the plurality of resistances are in parallel with one another."


Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B Jeanglaude whose telephone number is 703-306-3405. The examiner can normally be reached on Monday - Friday 7:30 A. M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Tokar can be reached on 703-305-3493. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

JBIG
September 7, 2001


PÉGUY JEANPIERRE
PRIMARY EXAMINER